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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/089,458   | 04/01/2002  | Mordechai Teicher    | P-4969-US           | 9465             |
| 27130  | 7590        | 04/22/2005           | EXAMINER            |                  |
| EITAN, PEARL, LATZER & COHEN ZEDEK LLP<br>10 ROCKEFELLER PLAZA, SUITE 1001<br>NEW YORK, NY 10020 |             |                      | HIRL, JOSEPH P      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2129                |                  |

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                   |                         |  |
|------------------------------|-----------------------------------|-------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b>            | <b>Applicant(s)</b>     |  |
|                              | 10/089,458                        | TEICHER, MORDECHAI      |  |
|                              | <b>Examiner</b><br>Joseph P. Hirl | <b>Art Unit</b><br>2129 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 01 April 2002.

2a)  This action is FINAL.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-5 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-5 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 01 April 2002 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

**DETAILED ACTION**

1. Claims 1-5 are pending in this application.

***Oath/Declaration***

2. On page 1, under the paragraph that claims foreign priority benefits, applicant has listed a PCT and two United States Provisional Applications which are not foreign applications. On page 2, applicant has not listed the PCT which is to be treated for domestic priority benefits. The subject declaration must be changed to properly reflect the claiming of foreign and domestic priority benefits.

***Abstract***

3. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text and limited to 150 words in length. The paper requirements of MPEP 608.01 (37 CFR 1.52(b)(2)(ii) require capital letters which are at least .21 cm high.

***Specification***

4. The specification requirements of MPEP 608.01 (37 CFR 1.71(f)) require that each sheet including part of the specification may not include other parts of the application or other information. The application as submitted is a copy of a PCT application. The applicant is requesting a United States Patent. PCT/WO heading notation on each page tends to confuse the processing of the application. In accordance the MPEP 608.01, the applicant must remove all PCT/WO notation from the headings of each page of the disclosure.
5. The specification requirements of MPEP 608.01(a) set forth the framing requirements by titles and appropriate lettering. Applicant is required to conform to such requirements.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
7. Claim 5 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an action that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under

35 U.S.C. 101. This rejection can be overcome by inserting the term "computerized" before "method" in the preamble.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by ePSO (<http://www.jrc.es/cfapp/invent/details.cfm?uid=151>, referred to as ePSO).

Examiner's Note (EN): The prior art was last updated on March 29, 2001 but contains material that dates to 1997 and specifically to February 1999 concerning the WiSP payment solution that is referenced below.

**Claim 1**

ePSO anticipates (a) a stored-value point-of-sale for receiving said first micropayment on behalf of said first merchant (ePSO, p 1, l 8; p 2, l 1-11); (b) a service provider computer including a service provider stored-value payment unit for making said first micropayment to said stored-value point-of-sale (ePSO, p 2, l 1-11); and a customer billing unit for billing said first customer in accordance with said making of said first micropayment (ePSO, p 2, l 1-11); and c) a first customer terminal

operable by said first customer to make said first purchase, said first purchase including said first micropayment (ePSO, p 1, l 20-36; p 2, l 1-11).

**Claim 2**

ePSO anticipates making a second micropayment for a second purchase by a second customer to said first merchant, the system further comprising a second customer terminal operable by the second customer to make the second purchase, said second customer terminal including a customer stored-value payment unit to make the second micropayment for the second purchase into said stored-value point-of-sale (ePSO, p 1, l 20-36; p 2, l 1-11).

**Claim 3**

ePSO anticipates the first merchant operates a first commerce server and said stored-value point-of-sale forms part of said first commerce server (ePSO, p 1, l 20-36; p 2, l 1-11; EN: para 13. applies; servers are computers and the first merchant will by nature of being a merchant, have a computer and such point-of-sale will have been initiated at that point and be so recorded on/in the merchant's computer).

**Claim 4**

ePSO anticipates said first merchant operates a first commerce server and said stored-value point-of-sale is remote from said first commerce server and is operative to sending a payment acknowledgement signal to said first commerce server upon receiving said payment from said service provider stored-value payment unit (ePSO, p 1, l 20-36; p 2, l 1-11; EN: para 13. applies; the monthly statements operate to inform the first commerce server of payment).

**Claim 5**

ePSO anticipates (a) sending an order for the merchandise from the customer (ePSO, p 1, l 20-36; p 2, l 1-11); (b) making a stored-value payment for the merchandise to the merchant from the service provider (ePSO, p 1, l 20-36; p 2, l 1-11); and (c) billing the customer for the merchandise by the service provider (ePSO, p 1, l 20-36; p 2, l 1-11).

***Examination Considerations***

10. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, l 45-48; p 2100-9, c 1, l 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

11. Examiner's Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further

indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are not prior art but a link to prior art that one of ordinary skill in the art would find inherently appropriate.

12. Unless otherwise annotated, Examiner's statements are to be interpreted in reference to that of one of ordinary skill in the art. Statements made in reference to the condition of the disclosure constitute, on the face of it, the basis and such would be obvious to one of ordinary skill in the art, establishing thereby an inherent *prima facie* statement.

13. Examiner's Opinion: Paras 10.-12. apply. The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

### ***Conclusion***

14. The prior art of record and not relied upon is considered pertinent to applicant's disclosure.

- ePSO Inventory DataBase (<http://www.jrc.es/cfapp/invent/details.cfm?uid=151>)
- Trivnet Ltd. & SoundBuzz Announce Partnership  
(<http://www.gdse.com/modules.php?name=News&file=article&sid=180>)
- Ecommerce Revenue without the Effort (<http://isp-planet.com/services/trivnet1.html>)

- Big Dreams for Tiny Money  
(<http://www.computerworld.com/news/1999/story/0,11280,37840,00.html>)
- Tomalak's Realm, Today's Links  
(<http://www.tomalak.org/todayslinks/1999/05/17.html>)
- Beenz Counters (<http://time.com/time/europe/magazing/2000/0605/beenz.html>)
- Wireless Electronic Security, Nokia
- WISP Internet Payment Service  
([http://www.trivnet.com/newsroom/in\\_news/index.asp?item=42](http://www.trivnet.com/newsroom/in_news/index.asp?item=42))

15. Claims 1-5 are rejected.

#### ***Correspondence Information***

16. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (571) 272-3685. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Knight can be reached at (571) 272-3687. Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,  
Washington, D. C. 20231;

or faxed to:

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(703) 872-9306 (for formal communications intended for entry);

or faxed to:

(571) 273-3685 (for informal or draft communications with notation of  
"Proposed" or "Draft" for the desk of the Examiner).



Joseph P. Hirsh

April 14, 2005